

#19/ Reply Brief
4/26/02
A.S.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): SHAW ET AL.

SERIAL NO.: 09/074,093

ART UNIT: 2684

FILING DATE: 5/7/98

EXAMINER: A. Gantt

TITLE: PORTABLE RADIO

RECEIVED

ATTORNEY

DOCKET NO.: 200-007950-US (PAR)

APR 25 2002

Technology Center 2600

Commissioner of Patents

Washington, DC 20231

ATTENTION: USPTO BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

This a reply brief in response to the Examiner's Answer mailed April 5, 2002, the reply brief being filed under 37 C.F.R. 1.193(b)(1). This brief is being submitted in triplicate. Please charge any fees associated with the filing of this Reply Brief to charge deposit account #16-1350.

In addition, to the various legal issues raised by Appellant in the brief dated January 21, 2002, it is also respectfully submitted that the Examiner has not set forth the factual evidence to support a proper and valid rejection of the claims under 35 U.S.C. 103 (a). As stated in In re Lee 61 USPQ2d 1430 @ page 1433-1434:

[1] As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis hereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d, 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obvious holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v.

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason and skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references").

In view of the arguments presented above and those presented in APPELLANT'S BRIEF, it is respectfully requested that the Examiner's rejections of Claims 1-27 be reversed.

Respectfully submitted.


Melvin J. Scolnick (Reg. No. 25, 233)


Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06430
(203) 259-1800 (ext. 133)
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231, Attention: BOARD OF PATENT APPEALS AND INTERFERENCES

Date: 4/17/02

Signature: *Lasanna Belencha*
Person Making Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): SHAW ET AL.

SERIAL NO.: 09/074,093

ART UNIT: 2684

FILING DATE: 5/7/98

EXAMINER: A. Gantt

TITLE: PORTABLE RADIO

ATTORNEY

DOCKET NO.: 200-007950-US (PAR)

RECEIVED

APR 25 2002

Technology Center 2600

Commissioner of Patents

Washington, DC 20231

ATTENTION: USPTO BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

This a reply brief in response to the Examiner's Answer mailed April 5, 2002, the reply brief being filed under 37 C.F.R. 1.193(b)(1). This brief is being submitted in triplicate. Please charge any fees associated with the filing of this Reply Brief to charge deposit account #16-1350.

In addition, to the various legal issues raised by Appellant in the brief dated January 21, 2002, it is also respectfully submitted that the Examiner has not set forth the factual evidence to support a proper and valid rejection of the claims under 35 U.S.C. 103 (a). As stated in In re Lee 61 USPQ2d 1430 @ page 1433-1434:

[1] As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis hereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d, 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obvious holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v.

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason and skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references").

In view of the arguments presented above and those presented in APPELLANT'S BRIEF, it is respectfully requested that the Examiner's rejections of Claims 1-27 be reversed.

Respectfully submitted.


Melvin J. Scolnick (Reg. No. 25, 233)


Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06430
(203) 259-1800 (ext. 133)
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231, Attention: BOARD OF PATENT APPEALS AND INTERFERENCES

Date: 4/17/02

Signature: *Roberta Belencha*
Person Making Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): SHAW ET AL.

SERIAL NO.: 09/074,093

ART UNIT: 2684

FILING DATE: 5/7/98

EXAMINER: A. Gantt

TITLE: PORTABLE RADIO

ATTORNEY

DOCKET NO.: 200-007950-US (PAR)

RECEIVED

APR 25 2002

Technology Center 2600

Commissioner of Patents

Washington, DC 20231

ATTENTION: USPTO BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

This a reply brief in response to the Examiner's Answer mailed April 5, 2002, the reply brief being filed under 37 C.F.R. 1.193(b)(1). This brief is being submitted in triplicate. Please charge any fees associated with the filing of this Reply Brief to charge deposit account #16-1350.

In addition, to the various legal issues raised by Appellant in the brief dated January 21, 2002, it is also respectfully submitted that the Examiner has not set forth the factual evidence to support a proper and valid rejection of the claims under 35 U.S.C. 103 (a). As stated in In re Lee 61 USPQ2d 1430 @ page 1433-1434:

[1] As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis hereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d, 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obvious holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v.

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason and skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references").

In view of the arguments presented above and those presented in APPELLANT'S BRIEF, it is respectfully requested that the Examiner's rejections of Claims 1-27 be reversed.

Respectfully submitted.


Melvin J. Scolnick (Reg. No. 25, 233)


Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06430
(203) 259-1800 (ext. 133)
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231, Attention: BOARD OF PATENT APPEALS AND INTERFERENCES

Date: 4/17/02

Signature: Roberta Belencha
Person Making Deposit